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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,264	08/14/2006	Roland Wursche	291789US0PCT	6049
22850 7590 06/25/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
FREEMAN, JOHN D				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
06/25/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/589,264

Applicant(s)

WURSCHE ET AL.

Examiner

John Freeman

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CIS-300)
- Paper No(s)/Mail Date 3/25/09

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. For clarity, the examiner notes monomer unit (I) and monomer unit (VI) are the elected species for (a) and (b) respectively. The other monomeric units are withdrawn from consideration.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oenbrink et al. (US 5,637,408) in view of Goldman (US 4,278,576).
4. Oenbrink discloses a multilayer composite comprising (col 1 In 55-63):
 - (I) a layer of polyamide,
 - (II) a layer of polyalkyl methacrylate, bonded via
 - (III) a coupling layer.

The coupling layer comprises (i) up to 96% by weight of acrylate-derived units (col 4 In 35-45), and (iv) 0.2-25% by weight of anhydride-based units (col 4 In 66-col 5 In 10).

5. Oenbrink is silent with the addition of ABS to the coupling layer.
6. Goldman discloses impact modifier polymer powders (col 1 In 7-10). Such impact modifiers include ABS (col 2 In 29).
7. It has long been an axiom of United States patent law that it is not inventive to discover the optimum or workable ranges of result-effective variables by routine experimentation. *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003) ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); *In re Boesch*, 617 F.2d 272, 276 (CCPA 1980) ("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the

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skill of the art."); *In re Aller*, 220 F.2d 454, 456 (CCPA 1955) ("[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."); "Only if the 'results of optimizing a variable' are 'unexpectedly good' can a patent be obtained for the claimed critical range." *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) (quoting *In re Antonie*, 559 F.2d 618, 620 (CCPA 1977)).

8. At the time of the invention, it would have been obvious to one of ordinary skill in the art to add ABS polymer to the coupling layer to improve the impact resistance of the layer. Further, it would have been obvious to use amounts falling within the presently claimed range to achieve an impact resistant layer that is not too brittle.

9. Regarding claim 7:

10. Polyalkyl methacrylate layers are inherently functional: Oenbrink uses them for mechanical properties and UV resistance (col 1 ln 13-25).

11. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ries et al. (US 6,680,093) in view of Goldman (US 4,278,576).

12. Ries disclose a multilayer composite comprising (claim 1):

- (I) a layer of polyamide,
- (II) a layer comprising polyester or fluoropolymer, bonded via
- (III) an adhesive layer.

The adhesive layer comprises an alkyl acrylate polymer comprising (i) up to 100% of acrylate-derived units, and (iv) 0-20% by weight of anhydride-based units (claims 4-6). The composite can be in a sheet form (col 7 ln 36-41).

13. Ries is silent with the addition of ABS to the coupling layer.

14. Goldman discloses impact modifier polymer powders (col 1 ln 7-10). Such impact modifiers include ABS (col 2 ln 29).

15. It has long been an axiom of United States patent law that it is not inventive to discover the optimum or workable ranges of result-effective variables by routine experimentation. *In re Peterson*, 315

F.3d 1325, 1330 (Fed. Cir. 2003) ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); *In re Boesch*, 617 F.2d 272, 276 (CCPA 1980) ("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art."); *In re Aller*, 220 F.2d 454, 456 (CCPA 1955) ("[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."); "Only if the 'results of optimizing a variable' are 'unexpectedly good' can a patent be obtained for the claimed critical range." *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) (quoting *In re Antonie*, 559 F.2d 618, 620 (CCPA 1977)).

16. At the time of the invention, it would have been obvious to one of ordinary skill in the art to add ABS polymer to the adhesive layer to improve the impact resistance of the layer. Further, it would have been obvious to use amounts falling within the presently claimed range to achieve an impact resistant layer that is not too brittle.

17. Regarding claim 7:

18. Polyester or fluoropolymer layers are inherently functional: they inherently provide water and/or chemical resistance.

Claim Rejections - 35 USC § 112

19. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

21. Claim 7 recites layers including a "color layer" and a "functional layer." It is unclear what is meant or encompassed by these terms.

Response to Arguments

22. Applicant's arguments with respect to claims 6-7 have been considered but are moot in view of the new ground(s) of rejection.
23. The examiner maintains the rejection of claim 7 under 35 USC 112. Although Applicant points to the specification for various embodiments of "color layers" and "functional layers", it is not clear that the claims are limited to those specifically listed. Further, it is not clear if other undisclosed layers may fall under the scope of these terms.
24. Applicant submits comparative data, specifically Table 1 of the specification, which shows no separation of bond partners among inventive examples and separation of bond partners among comparative examples. The data are not found to be persuasive because the examiner maintains Oenbrink in view of Goldman and Ries in view of Goldman disclose the presently claimed multilayer films, and therefore would intrinsically have the claimed properties. Also the data are not commensurate in scope with the claims because the data highlight specific polymers while the present claims recite multiple polymers that each have a wide range of possible monomer/polymer content, and very general layers as in claim 7.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Freeman whose telephone number is (571)270-3469. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Freeman
Examiner
Art Unit 1794

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/Callie E. Shosho/
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